

Claims 1 and 3 stand rejected under Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as their invention. Applicant respectfully traverses this rejection.

In particular, the Patent Office asserts that the term "identifying" in claim 1 is vague and indefinite. Applicant traverses this rejection and asserts in reply that one skilled in the art would readily understand the meaning of the term as it is used in claim 1. The use of the term "identifying" in this sense is meant to communicate that one may "identify" a transformed plant cell line by a screenable method as well as by a "selection" method. This aspect of the invention is fully described on pages 17-18 of the specification. Withdrawal of this rejection is respectfully solicited.

Applicant has deleted the term "limitation" from claim 3 to render the claim more definite and has clarified the antecedent basis matter of claim 1.

#### Section 102 rejection

Claims 1, 2, 10, 12 and 15 stand rejected under Section 102(b) as being anticipated by Hiei et al. This rejection is respectfully traversed. The Patent Office has asserted that the method of Hiei et al is the "same as" the claimed method, but is unable to identify anywhere in Hiei et al a step in the disclosed process of co-culturing the Agrobacterium and plant cell or tissue under conditions that decrease the weight of the Agrobacterium-inoculated explant as specifically claimed by Applicant. There is simply no disclosure in Hiei et al of this novel step. This rejection must be withdrawn.

Similarly, claims 1, 2, 11 and 16 stand rejected under Section 102(b) as being anticipated by Di et al. This rejection is respectfully traversed. The Patent Office has asserted that the method of Di et al is the "same as" the claimed method, but is unable to identify anywhere in Di et al a step in the disclosed process of co-culturing the Agrobacterium and plant cell or tissue under conditions that decrease the weight of the Agrobacterium-inoculated explant as specifically claimed by Applicant. There is simply no disclosure in Di et al of this novel step. This rejection must be withdrawn.

#### Section 103 rejection

Claims 1 and 3-9 stand rejected under Section 103 as being unpatentable over Hiei et al. As before, the Patent Office has acknowledged that Hiei et al does not disclose the removal of moisture from an Agrobacterium-inoculated explant. The Patent Office does however rely upon what is asserted as being "well known to those skilled in the art to remove excess weight from the explant or calli by applying Whatman's paper or other absorbency material such as Nitrocellulose, prior to placing explant, in regeneration or selection media." The Patent Office has not provided any substantiation of this statement and has provided no references in support of this position. Applicant respectfully requests that the Patent Office provide evidence of its position in either written form or in the form of a declaration of the Examiner or Patent Office to provide evidence in support of the position it has taken herein. Moreover, Applicant respectfully asserts that it was not well known to those skilled in the art to incorporate a step in a transformation method to decrease the weight of the Agrobacterium-inoculated explant. Therefore, the claims are not obvious and the rejection must be withdrawn.



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Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account No. 13-4125.

Applicant invites the Examiner to call the undersigned if clarification on any of this response, or if the Examiner believes that a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Pharmacia/Monsanto Company  
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